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In re Application of	:	
LOWE, et al.	:	
U.S. Application No.: 10/573,097	:	DECISION ON REQUEST
PCT No.: PCT/GB04/04093	:	
Int. Filing Date: 27 September 2004	:	UNDER 37 CFR 1.48(b)
Priority Date: 25 September 2003	:	
Attorney Docket No.: GJE-7492	:	
For: OPHTHALMIC DEVICE COMPRISING A	:	
HOLOGRAPHIC SENSOR	:	

This decision is in response to applicant's correspondence filed 08 February 2008 referencing a preliminary amendment and request for deletion of inventors. For the reasons discussed below, the request will be handled by the examiner of record.

BACKGROUND

On 27 September 2004, applicant filed international application PCT/GB04/04093, which claimed priority of an earlier application filed 25 September 2003. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 07 April 2005. Pursuant to 37 CFR 1.495, the thirty-month period for paying the basic national fee in the United States expired at midnight on 25 March 2006.

On 23 March 2006, applicant filed a transmittal letter for entry into the national stage in the United States, which was accompanied by the requisite basic national fee as required by 35 U.S.C. 371(c)(1); a preliminary amendment and an unsigned declaration.

On 12 February 2007, applicant was mailed a NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 (Form PCT/DO/EO/905) informing applicant of the need to provide an executed oath or declaration of the inventors, in compliance with 37 CFR 1.497(a) and (b), identifying the application by the International application number and international filing date. Applicant was given two months to respond and advised that this time period could be extended with a proper petition and payment of fees.

On 12 September 2007, applicant filed a combined declaration and power of attorney listing and executed by three of the six inventors listed on the corresponding, published international application.

On 16 January 2008, applicant was mailed a NOTIFICATION OF DEFECTIVE

RESPONSE (Form PCT/DO/EO/916) informing applicant that the filed declaration was defective in that it had not been executed by the 4th, 5th and 6th inventors listed on the published international application. Applicant was afforded one month or the extendable time remaining from the Form PCT/DO/EO/905 to file a proper response.

On 08 February 2008, applicant filed a response referencing a preliminary amendment filed 19 June 2007 amending claims resulting in Christopher Robin Lowe, Satyamoorthy Kabilan and Jeffrey Blyth as named inventors in the application.

DISCUSSION

Applicant is advised that the removal of inventors as a result of a change in the claims is handled under 37 CFR 1.48(b), however, the present national stage application must first be executed by all the named inventors. The filing of a petition under 37 CFR 1.48(b) is not applicable prior to the application being executed by the inventors named in the international application. Under 35 U.S.C. 363, an international application designating the United States has the effect of a national application for a patent regularly filed in the United States. In other words, the U.S. national stage application is considered to have been filed on the international filing date in the names of the inventors/applicants for the United States of America listed on the REQUEST form. The REQUEST indicated Christopher Robin Lowe, Satyamoorthy Kabilan, Jeffrey Blyth, Angelika Domschke, Dawn Smith and Njeri Karangu as applicants/inventors for the United States of America.

37 CFR 1.48(f)(1), by its terms, applies only to a non-provisional application filed under 37 CFR 1.53(b). (See also, 37 CFR 1.9(a)(3)). A national application resulting from an international application entering the national stage under 37 U.S.C. 371 is not an application filed under 37 CFR 1.53(b), but an application that has entered that national stage under 37 CFR 1.494 or 1.495.

Accordingly, the requirements under 35 U.S.C. 371(c)(4) must be met, namely, that an oath or declaration of the inventors complying with the regulations for oaths or declaration of applications be filed. As set forth in 37 CFR 1.497, the oath or declaration must be executed by all the inventors. It is noted that the unsigned declaration filed 23 March 2006 lists the sixth named inventor, Njeri Karangu, as deceased. Applicant is directed to 37 CFR 1.42 which discusses courses of action for where an inventor is deceased.

CONCLUSION

For the reasons stated above, the request under 37 CFR 1.48(b) will be held in abeyance pending the filing of a compliant oath or declaration under 37 CFR 1.497. Once the 35 U.S.C. 371 requirements have been satisfied the request will be handled in the group art unit.

Any further correspondence with respect to this matter should be directed to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

A handwritten signature in black ink, appearing to read 'Derek A. Putonen'.

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